

TITLE 35.—PATENTS

PART II.—PATENTABILITY OF INVENTIONS AND GRANT OF PATENTS

Chapter 11.—APPLICATION FOR PATENT

§ 119. Benefit of earlier filing date in foreign country; right of priority.

JAPANESE AND CERTAIN GERMAN NATIONALS; TEMPORARY EXTENSION OF PRIORITY RIGHTS

Act Aug. 23, 1954, ch. 823, 68 Stat. 764, provided that: "The rights of priority specified in section 1 of Public Law 690, Seventy-ninth Congress, approved August 8, 1946 (60 Stat. 940), which arose before April 1, 1950, are hereby extended, with respect to inventions made subsequent to January 1, 1946, in favor of nationals of Japan, and of nationals of Germany, excluding persons residing in or subject to the jurisdiction of the zone of Germany occupied by the Union of Soviet Socialist Republics, the Soviet sector of Berlin or other areas of Germany under Soviet or Polish administration, to a date nine months after the enactment of this Act [Aug. 23, 1954], subject to the conditions and limitations specified in sections 1, 4, 10, 12, and 15 of said Public Law 690. "For the purpose of this act, the phrase "passage of this Act" in said Public Law 690 shall be understood to refer to the date of enactment of the present Act [Aug. 23, 1954]."

Public Law 690, Seventy-ninth Congress, approved August 8, 1946 (60 Stat. 940), referred to in act Aug. 23, 1954 quoted above, is act Aug. 8, 1946, ch. 910, 60 Stat. 940, and sections 1, 4, 10, 12, and 15 of such latter act, referred to in said act Aug. 23, 1954, were classified to sections 101, 104, 110, 112, and 114 of this title prior to its revision and enactment into law by act July 19, 1952, ch. 950, 66 Stat. 792. They were omitted from this revised title because of their temporary character.

Chapter 15.—PLANT PATENTS

§ 161. Patents for plants.

Whoever invents or discovers and asexually reproduces any distinct and new variety of plant, including cultivated sports, mutants, hybrids, and newly found seedlings, other than a tuber propagated plant or a plant found in an uncultivated state, may obtain a patent therefor, subject to the conditions and requirements of this title.

The provisions of this title relating to patents for inventions shall apply to patents for plants, except as otherwise provided. (As amended Sept. 3, 1954, ch. 1259, 68 Stat. 1190.)

AMENDMENTS

1954—Act Sept. 3, 1954, amended section to provide that plant seedlings, discovered, propagated asexually, and proved to have new characteristics distinct from other known plants are patentable.

§ 164. Assistance of Department of Agriculture.

TRANSFER OF FUNCTIONS

All functions of all officers, agencies and employees of the Department of Agriculture were transferred, with certain exceptions, to the Secretary of Agriculture by 1953 Reorg. Plan No. 2, § 1, eff. June 4, 1953, 18 F. R. 3219, 67 Stat. 633, set out as a note under section 511 of Title 5, Executive Departments and Government Officers and Employees.

Chapter 17.—SECRECY OF CERTAIN INVENTIONS AND FILING APPLICATIONS IN FOREIGN COUNTRY

§ 181. Secrecy of certain inventions and withholding of patent.

DEFENSE AGENCIES

The Department of Justice was designated as a defense agency of the United States for the purposes of this chapter by Executive Order No. 10457, May 28, 1953, 18 F. R. 3083.

§ 188. Rules and regulations, delegation of power.

DEFENSE AGENCIES

The Department of Justice was designated as a defense agency of the United States for the purposes of this chapter by Executive Order No. 10457, May 28, 1953, 18 F. R. 3083.

REGULATIONS RELATING TO SECRECY OF CER- TAIN INVENTIONS AND LICENSES TO FILE APPLICATIONS IN FOREIGN COUNTRIES

Title 37, Part 5, Code of Federal Regulations

The following regulations relating to the secrecy of certain inventions and licenses to file applications in foreign countries, have been established under authority of sections 6 and 188 of this title; they interpret or apply sections 181—188 of this title.

These regulations were published in the Federal Register for February 20, 1953, 18 F. R. 1011. They form Part 5 of Title 37 of the Code of Federal Regulations.

SECRECY ORDERS

37 C. F. R.

Sec.

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SECRECY ORDERS

5.1 DEFENSE INSPECTION OF CERTAIN APPLICATIONS

In accordance with the provisions of 35 U. S. C., section 181, applications for patent containing subject matter the disclosure of which might be detri-

mental to the national security are made available for inspection by defense agencies as specified in said section. Only applications obviously relating to national security, and applications within fields indicated to the Patent Office by the defense agencies as so related, are made available. Such inspection must be at the Patent Office and by responsible representatives of the agency who are required to sign a dated acknowledgment of such access accepting the condition that information obtained from the inspection will be used for no other purpose than in the administration of sections 181—188 of Title 35, U. S. Code. Applications relating to atomic energy are made available to the Atomic Energy Commission as specified in section 1.14 of this chapter (Patent Rule 14).

5.2 SECRECY ORDER

When notified by the chief officer of a defense agency that publication or disclosure of the invention by the granting of a patent would be detrimental to the national security, an order that the invention be kept secret will be issued by the Commissioner of Patents.

The secrecy order is directed to the applicant, his successors, any and all assignees, and their legal representatives, hereinafter designated as principals.

A copy of the secrecy order will be forwarded to each principal of record in the application and will be accompanied by a receipt, identifying the particular principal, to be signed and returned.

The secrecy order is directed to the subject matter of the application. Where any other application in which a secrecy order has not been issued discloses a significant part of the subject matter of the application under secrecy order, the other application and the common subject matter should be called to the attention of the Patent Office. Such a notice may include any material such as would be urged in a petition to rescind secrecy orders on either of the applications.

5.3 PROSECUTION OF APPLICATION UNDER SECRECY ORDER; WITHHOLDING PATENT

Unless specifically ordered otherwise, action on the application by the office and prosecution by the applicant will proceed during the time an application is under secrecy order to the point indicated below:

(a) Applications under secrecy order which come to a final rejection must be appealed or otherwise prosecuted to avoid abandonment. Appeals in such cases must be completed by the applicant but unless otherwise specifically ordered by the Commissioner will not be set for hearing until the secrecy order is removed.

(b) Interferences may be declared involving an application under secrecy order but unless otherwise specifically ordered or permitted such interferences are suspended after the approval of the preliminary statements.

(c) When the application is found to be in condition for allowance except for the secrecy order, the

applicant and the agency which caused the secrecy order to be issued will be notified. This notice (which is not a notice of allowance under section 1.311 of this chapter (Patent Rule 311)) does not require response by the applicant and places the application in a condition of suspension until the secrecy order is removed. When the secrecy order is removed the Patent Office will issue a notice of allowance under section 1.311 (Patent Rule 311) or take such other action as may then be warranted.

5.4 PETITION FOR RESCISSION OF SECRECY ORDER

A petition for rescission or removal of a secrecy order may be filed by, or on behalf of, any principal affected thereby. Such petition may be in letter form, and it must be in duplicate. The petition must be accompanied by one copy of the application or an order for the same, unless a showing is made that such a copy has already been furnished, to the department or agency which caused the secrecy order to be issued.

The petition must recite any and all facts that purport to render the order ineffectual or futile if this is the basis of the petition. When prior publications or patents are alleged the petition must give complete data as to such publications or patents and should be accompanied by copies thereof.

The petition must identify any contract between the Government and any of the principals, under which the subject matter of the application or any significant part thereof was developed, or to which the subject matter is otherwise related. If there is no such contract, the petition must so state.

Unless based upon facts of public record, the petition must be verified.

5.5 PERMIT TO DISCLOSE OR MODIFICATION OF SECRECY ORDER

Consent to disclosure, or to the filing of an application abroad, as provided in 35 U. S. C. 182, shall be made by a "permit" or "modification" of the secrecy order.

Petitions for a permit or modification must fully recite the reason or purpose for the proposed disclosure. Where any proposed discloser is known to be cleared by a defense agency to receive classified information, adequate explanation of such clearance should be made in the petition including the name of the agency or department granting the clearance and the date and degree thereof. The petition must be filed in duplicate and be accompanied by one copy of the application or an order for the same, unless a showing is made that such a copy has already been furnished to the department or agency which caused the secrecy order to be issued.

In a petition for modification of a secrecy order to permit filing abroad, all countries in which it is proposed to file must be made known, as well as all attorneys, agents and others to whom the material will be consigned prior to being lodged in the foreign patent office. The petition should include a statement vouching for the loyalty and integrity of

the proposed disclosees and where their clearance status in this or the foreign country is known all details should be given.

Consent to the disclosure of subject matter from one application under secrecy order may be deemed to be consent to the disclosure of common subject matter in other applications under secrecy order so long as not taken out of context in a manner disclosing material beyond the modification granted in the first application.

The permit or modification may contain conditions and limitations.

5.6 GENERAL AND GROUP PERMITS

Organizations requiring consent for disclosure of applications under secrecy order to persons or organizations in connection with repeated routine operation may petition for such consent in the form of a general permit. To be successful such petitions must ordinarily recite the security clearance status of the disclosees as sufficient for the highest classification of material that may be involved.

Where identical disclosees and circumstances are involved, and consent is desired for the disclosure of each of a specific list of applications, the petitions may be joined.

5.7 COMPENSATION

Any request for compensation as provided in 35 U. S. C. 183 must not be made to the Patent Office but should be made directly to the department or agency which caused the secrecy order to be issued. Upon written request persons having a right to such information will be informed as to the department or agency which caused the secrecy order to be issued.

5.8 APPEAL TO SECRETARY

Appeal to the Secretary of Commerce, as provided by 35 U. S. C. 181, from a secrecy order cannot be taken until after a petition for rescission of the secrecy order has been made and denied. Appeal must be taken within 60 days from the date of the denial, and the party appealing, as well as the department or agency which caused the order to be issued will be notified of the time and place of hearing. The appeal will be heard and decided by the Secretary or such officer or officers as he may designate.

LICENSES FOR FOREIGN FILING

5.11 LICENSE FOR FILING APPLICATION IN FOREIGN COUNTRY

(a) When no secrecy order has been issued under section 5.2, a license from the Commissioner of Patents under 35 U. S. C. 184 is required before filing any application for patent or for the registration of a utility model, industrial design, or model, in a foreign country, or causing or authorizing such filing, with respect to an invention made in the United States, if

(1) The foreign application is to be filed or its filing caused or authorized before an application for patent is filed in the United States, or

(2) The foreign application is to be filed, or its filing caused or authorized, prior to the expiration of six months from the filing of the application in the United States.

(b) When there is no secrecy order in effect, a license under 35 U. S. C. 184 is not required if

(1) The invention was not made in the United States, or

(2) The foreign application is to be filed, or its filing caused or authorized, after the expiration of six months from the filing of the application in the United States.

(c) When a secrecy order has been issued under section 5.2, an application cannot be filed in a foreign country in any case except in accordance with section 5.5.

5.12 PETITION FOR LICENSE

Petitions for license under 35 U. S. C. 184 may be presented in letter form and should include petitioner's address, and full instructions for delivery of the requested license when it is to be delivered to other than the petitioner.

5.13 PETITION FOR LICENSE: NO CORRESPONDING U. S. APPLICATION

Where there is no corresponding United States application, the petition for license must be accompanied by a legible copy of the material upon which license is desired. This copy will be retained as the measure of the license granted. For assistance in the identification of the subject matter of each license so issued, it is suggested that the petition or requesting letter be submitted in duplicate and provide a title and other description of the material. The duplicate copy of the petition will be returned with the license or other action on the petition.

5.14 PETITION FOR LICENSE: CORRESPONDING U. S. APPLICATION

Where there is a corresponding United States application on file the petition for license must identify this application by serial number, filing date, inventor, and title, and a copy of the material upon which the license is desired is not required. The subject matter licensed will be measured by the disclosure of the United States application. Where the title is not descriptive, and the subject matter is clearly of no interest from a security standpoint, time may be saved by a short statement in the petition as to the nature of the invention.

Two or more United States applications should not be referred to in the same petition for license unless they are to be combined in the foreign application, in which event the petition should so state and the identification of each United States application should be in separate paragraphs.

Where the application to be filed abroad contains matter not disclosed in the United States application or applications, including the case where the combining of two or more United States applications introduces subject matter not disclosed in any of them, a copy of the application as it is to be filed in the foreign country must be furnished with the petition.

If, however, all new matter in the application to be filed is readily identifiable, the new matter may be submitted in detail and the remainder by reference to the pertinent United States application or applications.

5.15 SCOPE OF LICENSE

A license to file an application in a foreign country, when granted, includes authority to forward all duplicate and formal papers to the foreign country and to make amendments and take any action in the prosecution of the application, provided subject matter additional to that covered by the license is not involved. In those cases in which no license is required to file the foreign application, no license is required to file papers in connection with the prosecution of the foreign application not involving disclosure of additional subject matter. Any paper filed abroad following the filing of a foreign application, which involves the disclosure of additional subject matter must be separately licensed in the same manner as an application.

Licenses separately granted in connection with two or more United States applications may be exercised by combining or dividing the disclosures, as desired, provided additional subject matter is not introduced.

A license does not apply to acts done before the license was granted unless the petition specifically requests and describes the particular acts and the license is worded to apply to such acts.

5.16 EFFECT OF SECRECY ORDER

Any license obtained under 35 U. S. C. 184 is ineffective if the subject matter is under a secrecy order, and a secrecy order prohibits the exercise of or any further action under the license unless separately specifically authorized by a modification of the secrecy order in accordance with section 5.5.

5.17 WHO MAY USE LICENSE

Licenses may be used by any one interested in the foreign filing for or on behalf of the inventor or his assigns.

5.18 ARMS, AMMUNITION, AND IMPLEMENTS OF WAR

(a) The exportation of technical data relating to arms, ammunition, and implements of war is subject to the licensing jurisdiction of the Department of State, as set forth in its pertinent regulations (22 CFR 75.1 to 75.183). The articles designated as arms, ammunition, and implements of war are enumerated in 22 CFR 75.10, this list being known as the United States Munitions List. The exportation of technical data relating to articles on this list with any application for foreign patent is generally subject to the licensing requirements of the Secretary of State, 22 CFR 75.114.

(b) When a petition for license is received by the Commissioner, during the time in which a license from the Commissioner is required (see § 5.11a), and it is determined that the subject matter involved also falls under the jurisdiction of the Secretary of State, the applicant will be so notified and given whatever information may be deemed appropriate.

The petition for license will be referred by the Patent Office to the Department of State for its action. Action by the Patent Office on the petition will be deferred pending the Department of State consideration.

(c) If an application for patent for subject matter on the Munitions List (22 CFR 75.10) is subject to a secrecy order under § 5.2 and a petition under § 5.5 for a modification of the secrecy order to permit filing abroad is made, compliance with Department of State regulation 22 CFR 75.110 (c) is also required.

(d) When no license from the Commissioner is required, see § 5.11 (b), relating to the exportation of such technical data with applications for foreign patents, the specific provisions of the regulations issued by the Secretary of State cited above must be complied with.

GENERAL

5.21 EFFECT OF MODIFICATION, RESCISSION OR LICENSE

Any consent, rescission or license under the provisions of this part does not lessen the responsibilities of the principals in respect to any Government contract or the requirements of any other Government agency.

5.22 PAPERS IN ENGLISH LANGUAGE

All papers submitted in connection with petitions must be in the English language, or be accompanied by an English translation and a translator's certificate as to the true, faithful and exact character of the translation.

Chapter 26.—OWNERSHIP AND ASSIGNMENT

§ 261. Ownership; assignment.

EX. ORD. NO. 9424. ESTABLISHING A REGISTER OF GOVERNMENT INTERESTS IN PATENTS AND APPLICATIONS FOR PATENTS

Ex. Ord. No. 9424, Feb. 18, 1944, 9 F. R. 1959, provided:

1. The Secretary of Commerce shall cause to be established in the United States Patent Office a separate register for the recording of all rights and interests of the Government in or under patents and applications for patents.

2. The several departments and other executive agencies of the Government, including Government-owned, or Government-controlled corporations, shall forward promptly to the Commissioner of Patents for recording in the separate register provided for in paragraph 1 hereof all licenses, assignments, or other interests of the Government in or under patents or applications for patents, in accordance with such rules and regulations as may be prescribed pursuant to paragraph 4 hereof; but the lack of recordation in such register of any right or interest of the Government in or under any patent or application therefor shall not prejudice in any way the assertion of such right or interest by the Government.

3. The register shall be open to inspection except as to such entries or documents which, in the opinion of the department or agency submitting them for recording, should be maintained in secrecy: Provided, however, That the right of inspection may be restricted to authorized representatives of the Government pending the final report to the President by the National Patent Planning Commission under Executive Order No. 8977 of December 12, 1941, and action thereon by the President.

4. The Commissioner of Patents, with the approval of the Secretary of Commerce, shall prescribe such rules and regulations as he may deem necessary to effectuate the purposes of this order.